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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,525	10/12/2001	Pranitha Senarath	HRT-57089	3977

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EXAMINER  
MANTIS MERCADER, ELENI M

ART UNIT 3737  
PAPER NUMBER

DATE MAILED: 01/21/2004 7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,525

Applicant(s)

SENARITH ET AL.

Examiner

Eleni Mantis Mercader

Art Unit

3737

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 12/11/03 have been fully considered but they are not persuasive. Applicant's comment in page 6 of the remarks, stating: "...the claimed invention does not involve the determination of the future position of a device, so the relevance of Hwang is questioned." is not understood in view of the claimed language stating: "...and future present position coordinate data related to future positions of the device", which is now cancelled. Nonetheless, a new combination of references is made and hence this action is non-final.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea et al.'366 in view of Manwaring et al.'299.

D'Andrea et al.'366 teach all the features of the current invention including a processor which confirms that the current position of the capsule corresponds to a previous position of the device and once the matching is sensed then activation of samples or treatment at that specific location is triggered (col. 3, lines 1-47, also see claims 32-53; note in claim 48 that when the device is actuated by the operator to sample or treat when sensory indication is provided to the operator, also see in col. 5, lines 14-16, clearly stating that there is visual sensory indication of

Art Unit: 3737

the location of the device, matching the previous location and signaling the operator to trigger sampling or treatment).

D'Andrea et al.'366 do not explicitly teach the use of a magnetometer for localizing the device/capsule.

Manwaring et al.'299 teach tracking the location of an interventional device within an anatomical site, said system comprising:

a magnetometer system adapted to provide position coordinate data related to the present position of the device as the device is moved about the anatomical site (col. 5, lines 44-64; describing the tracking of the magnetometer as the way to determine the location of the surgical probe and col. 3, lines 19-67 & col. 4, lines 1-22; referring to the current location of the surgical probe and guiding the surgical probe by using the guided trajectory and col. 4, lines 24-67 and subsequent; describing embodiments of positioning a magnet about the anatomical site);

a processor communicating with a database having stored therein the coordinate data of a trajectory, the processor adapted to receive the current position coordinate data, and process the present-position coordinate data (col. 3, lines 31-57 and col. 4, lines 1-22; referring to the controller 18 which determines the current position of the surgical probe and memory 20 storing previously acquired tomograms and also see col. 9, lines 35-43; describing use of tomograms to guide the surgical probe by identifying its current location);

and a sensory indicator adapted to receive the position indication data from the processor and process the data to provide a sensory indication (col. 3, lines 58-67 and col. 4, lines 1-3; referring to the feedback device indicating the current position of the surgical probe as it relates to the target and the respective trajectory).

Art Unit: 3737

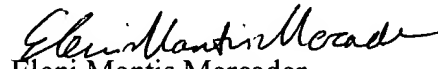
Manwaring et al.'299 teach the use of Cartesian coordinates (col. 9, lines 35-43) and/or polar coordinates (col. 9, lines 57-67 and col. 10, lines 1-7; describing angular determinations of the surgical probe).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified D'Andrea et al.'366 and incorporated the teachings of Manwaring et al.'299 in substituting one localization modality with a functional equivalent using a magnetometer as an alternative modality yielding the same end result which is accurate determination of the position of the capsule/device in the patient.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on 703 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.

  
Eleni Mantis Mercader  
Primary Examiner  
Art Unit 3737

EMM